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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,352	11/22/2006	Louis A. Carpino	8884	4886
22922 7590 08/25/2009 REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202				
EXAMINER COUGHLIN, MATTHEW P				
ART UNIT		PAPER NUMBER		
1626				
NOTIFICATION DATE		DELIVERY MODE		
08/25/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPAdmin@reinhardtllaw.com

### Office Action Summary

**Application No.**

10/577,352

**Applicant(s)**

CARPINO ET AL.

**Examiner**

Matthew P. Coughlin

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-31 and 56-76 is/are pending in the application.
- 4a) Of the above claim(s) 20-31, 69 and 71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 63 is/are rejected.
- 7) ☒ Claim(s) 56-62, 64-68, 70 and 72-76 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/29/2008, 09/22/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

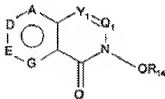
Claims 20-31 and 56-76 are pending in the application. Claim 63 is rejected. Claims 20-31, 69 and 71 are withdrawn from consideration. Claims 56-62, 64-68, 70 and 72-76 are objected to.

***Election/Restrictions***

Applicant's election of Group II, claims 56-76 (in part), in the reply filed on July 23<sup>rd</sup>, 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). NOTE: Group II reads on claims 56-68, 70 and 72-76, but does not read on claims 69 and 71.

Claims 20-31, 69 and 71 and the non-elected subject matter of claims 56-68, 70 and 72-76 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 23<sup>rd</sup>, 2009.

The subject of this examination, according to Group II, is the following core structure:



where Y<sub>1</sub> is nitrogen,

Q<sub>1</sub> is carbon,

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one of A, D, E, and G is nitrogen,  
and all other substituents are as defined within the instant claims.

### ***Priority***

This application is a 35 U.S.C. 371 National Stage Filing of International Application No. PCT/US04/36428, filed Monday, November 1<sup>st</sup>, 2004, which claims priority under 35 U.S.C. 119(e) to Provisional Application No. 60/516167, filed October 31<sup>st</sup>, 2003.

The disclosure of Provisional Application No. 60/516167 was examined due to intervening prior art (Carpino et al. J. Org. Chem. 2004, 69, 54-61, provided in the IDS filed December 29<sup>th</sup>, 2008), and the provisional application provides sufficient support under 35 USC 112 1<sup>st</sup> paragraph. Accordingly, the priority date of this application (with respect to the elected invention) for prior art purposes is October 31<sup>st</sup>, 2003.

### ***Information Disclosure Statement***

The Examiner has considered the Information Disclosure Statements filed on December 29<sup>th</sup>, 2008 and September 22<sup>nd</sup>, 2006.

### ***Claim Objections***

Claims 65 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 65 recites that R12 and R13 are independently lower alkyl, aryl, or aryl lower alkyl; however, the parent claim 56 does not provide for R12 and R13 to be aryl or aryl lower alkyl.

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Claim 67 is objected to because the value "R13" has been used where the parent claim uses "R11" to define the same position. It is suggested that Applicant amend claim 67 to replace "R13" with "R11".

Claim 70 is objected to because the word form is misspelled as "from." See the definition of R24, R25, R26 and R22.

Claims 60, 64, 68, 75 are objected to because they do not end in a period.

Claims 56-76 are objected to as being drawn to (in part) non-elected subject matter. It is suggested that Applicant delete this non-elected subject matter from the claims in the reply to this office action.

***Claim Rejections - 35 USC § 112***

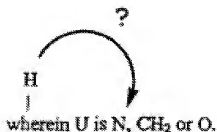
The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 63 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 63 recites the limitation that "U is N, CH<sub>2</sub> or O." There is a valence problem when U is N. The additional substituent on nitrogen has not been defined. It appears that there may have been a formatting error where the hydrogen atom that is presently not bound to anything should be bound to nitrogen. See below.

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***Allowable Subject Matter***

The elected subject matter appears to be free of the prior art. It is suggested that Applicant amend the claims to remove non-elected subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew P. Coughlin whose telephone number is (571)270-1311. The examiner can normally be reached on Monday through Thursday from 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew P. Coughlin/      /Rebecca L Anderson/  
Examiner, Art Unit 1626      Primary Examiner, Art Unit 1626